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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,984	12/03/2001	Didier Gloaguen	214711	9238

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EXAMINER

PICKARD, ALISON K

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/004,984

Applicant(s)

GLOAGUEN, DIDIER

Examiner

Alison K. Pickard

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain Patent No. 1,384,012.

GB '012 discloses a protective cover (bellows) having a deformable structure defining an interior space and closed at both ends. The cover includes a vent means 11 including a vent element 18 that allows air flow across while preventing contaminants and/or water from entering (page 1, lines 24-26). The vent means is a separate structure from the cover (bellows) (see claim 5, states the cover 11 is “attachable” to the bellows and therefore is considered separate). As seen in the figures, a portion of the cover is disposed within the vent means 11 to connect them. The vent means and cover (bellows) are further mechanically coupled via clips 16.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-8, 10, 11, 13, 15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colletti (3,927,576).

Colletti discloses a protective cover arrangement secured to both ends of a joint or steering arrangement in a vehicle. The cover comprises an elastomeric (col. 1, line 60) bellows 23 secured at each end with a collar 32 and 33 and defining an interior space 36. A vent means 28 is coupled to the space and includes an element 18 that allows airflow there across but prevents contaminants and/or water from entering the space (col. 1, lines 45-50). The pressure in the space is maintained at atmospheric pressure. The vent means prevents lubricant from escaping. The element 18 is made of a porosity-calibrated material. However, Colletti does not disclose that the material for the vent element is Teflon. Using Teflon as the material is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended purpose. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). It is known in the art to use Teflon as a filter material as evidenced by Gentilcore (5,052,451). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use Teflon for the vent element as a matter of choice in design.

5. Claims 1, 3, 5-8, 10-12, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '012.

GB '012 discloses a protective cover (bellows) having a deformable structure defining an interior space and closed at both ends. The cover includes a vent means 11 including a vent element 18 that allows air flow across while preventing contaminants and/or water from entering (page 1, lines 24-26). The vent means is a separate structure from the cover (bellows) (see claim 5, states the cover 11 is "attachable" to the bellows and therefore is considered separate). As seen in the figures, a portion of the cover is disposed within the vent means 11 to connect them. The vent means and cover (bellows) are further mechanically coupled via clips 16. The vent

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means is configured as an L-shaped spout having a first portion outwardly perpendicular to the axis, and a second portion parallel to the axis. GB '012 does not disclose the vent element is made of TEFLON. Using Teflon as the material is considered a design choice. It is not considered inventive to select a known material based on its suitability for its intended purpose. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). It is known in the art to use Teflon as a filter material as evidenced by Gentilcore (5,052,451). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use Teflon for the vent element as a matter of choice in design.

#### ***Response to Arguments***

6. Applicant's arguments filed 12-2-03 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references (i.e. modify the filter by making it from TEFLON), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the filters of GB '012, Colletti, and Gentilcore, are all provided to trap and prevent airborne contaminants from entering a space. Gentilcore is cited to show that it is known to make such a filter from TEFLON. Also, Applicant is arguing features which (i.e., water-tight pellets/hydrophobic) are not recited/required in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations

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from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims require that the filter prevents contaminants “and/or” water from entering. However, one of ordinary skill in the art would have the knowledge to use a Teflon filter, which would inherently be hydrophobic.

Regarding the GB reference, the examiner maintains that the bellows and cover (vent means) are separate structures coupled together via mechanical means (clips). Claim 5 of GB ‘012 states a supporting wall (the perpendicular wall) of the cover is “attachable” to the bellows. The clips are provided to further hold the cover in place, not just “permit the passage of air” as Applicant contends.

Applicant’s attention is also directed to Christiansen ‘885, which discloses a bellows with vent means and filter. The vent means can be formed separate from the bellows.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 703-305-0882.

The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alison K. Pickard  
Primary Examiner  
Art Unit 3676

AP